IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Eva Ackerman and Randy Gene Clark	§	Atty. Dkt. No.: 041443-00752
Serial No.: 09/764,572	§	Group Art Unit: 2831
Filed: January 18, 2001	§	Examiner: Patel, Dhirubhai R.
For: A Method of Assisting a Compromised Barrier	§	

APPEAL BRIEF

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APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby submit this Appeal Brief, in triplicate; the Notice of Appeal having been filed on December 27, 2005.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is The Rectorseal Corporation, a corporation organized under the laws of the state of Delaware, located at 2601 Spenwick Drive, Houston, Texas 77005, to whom this application has been assigned.

II. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences exist.

III. STATUS OF CLAIMS

As originally filed, this application contained Claims 1-22. These claims have all been cancelled. During prosecution of the application, Claims 23-45 were presented. Claims 28-36, 39 and 41-45 have been cancelled from this application. The Examiner has allowed no claims.

Claims 23-27, 37-38 and 40 have been rejected by the Examiner and are the claims on appeal. A copy of the claims on appeal is set forth in Appendix 1 hereto.

IV. STATUS OF AMENDMENTS

No amendments were made to the claims after issuance of the final rejection dated October 26, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

There are two independent claims on appeal – Claim 23 and Claim 27. The scope of each of the independent claims involved in the appeal is discussed in the paragraphs below; reference is made to the specification by page and line number and to the reference characters of the drawings.

During building construction, a barrier, such as a wall, floor or ceiling, is assigned a certain fire rating in accordance with approved testing standards. An electrical box mounted or otherwise introduced into the barrier often compromises the fire rating of the barrier by altering the barrier's previously tested rating. (P. 1, l. 20 – p. 2, l. 8.) The invention therefore is directed to a method of assisting such a compromised barrier, by reestablishing the fire rating of the barrier when that rating has been compromised by the introduction of an electrical box.

Claim 23 recites a method of assisting compromised barrier 2 by providing gasket 14 (p. 2, l. 20 – p. 3, l. 7) having a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite (p. 6, ll. 9-11) and placing fire retardant gasket

14 between a faceplate 12 and electrical box 10 (p. 6, ll. 21 through p. 7, ll. 4). - 23), coupling faceplate 12 to box 10 (p. 3, ll. 11-12); and at least partially reestablishing the fire rating of barrier 2 (p. 3, ll. 8-12); electrical box 10 then having been adapted to be introduced into barrier 2 (p. 7, ll. 5-9).

Claim 37 recites a method of assisting compromised barrier 2 caused by, in the first step, electrical box 10 having been installed into barrier 2 (p. 2, ll. 20-22; p. 4, ll. 13-19); and, in the second step, introducing into electrical box 10 fire retardant gasket 14 of a fire insulative material containing mineral wool or intumescent graphite (p. 5, ll. 6-11). Electrical box 10 is then covered with faceplate 12 (p. 6, l. 20 – p. 7, l. 4).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to be reviewed on appeal are as follows:

1. Whether Claims 23-27 are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. Whether Claims 23-27, 37-38 and 40 are unpatentable under 35 U.S.C. § 103(e) over U.S. Patent No. 6,521,834 ("*Dykhoff*") .

3. Whether Claims 23-26, 37-38 and 40 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 4,163,137 ("*Close*") in view of U.S. Patent No. 6,153,674 ("*Landin*") .

VII. ARGUMENTS

1. Rejection of Claims 23-27 Under 35 U.S.C. § 112, ¶ 2.

The Examiner's rejection is premised on the alleged failure of the specification to provide a definition of "at least partially reestablishing a fire rating of the barrier." (P. 15 of Final

Rejection.) Lines 10-11 of page 5 of the originally filed specification defines "at least partially reestablishing" as "fully or partially reestablishing".

One of skill in the art understands the concept of a fire rating. Regulatory standards and codes for the construction industry in relation to fire ratings are well documented in the art. *Note*, for instance, the discussion on page 6, ll. 11-19, of Appellants' originally filed specification. Appellants have continuously argued to the Examiner that one of skill in the art recognizes that barriers exhibit maximum fire ratings of 1, 2, 3 or 4 hours and that the claimed terminology "at least partially establishing a fire rating of the barrier" would mean bringing the rating back at least partially to its established rating. Appellants provided ASTM E 814-88 (attached as Exhibit 2 in Appendix 2) to further his understanding of "fire rating" as is known to those of skill in the art. Appellants further provided ASTM E-119 (attached as Exhibit 3 in Appendix 2) for an exemplary protocol for measuring the fire resistive properties of material and assemblies in buildings. A fire rating is a specific term of art for materials to withstand a fire for a specific time and for a specific temperature. A fire rating varies and is dependent on several factors, such as thickness of the barrier, square footage of the contained room or area, occupancy, proximity to explosive materials, etc.

The Examiner argues that Appellants fail to mention in the "Exhibit A" what standard was used for "F0419029" and "F0420037". The referenced Exhibit was submitted to support completion of Appellants' invention over *Dykhoff* in Declaration Under 37 C.F.R. § 1.131 of Randy Clark, filed on January 30, 2004 (attached as Exhibit 1 in Appendix 2).[1] The reference to "F0419029" and "F0420037" in "Exhibit A" refers to internal tests for plastic and steel face plates, respectively. The Examiner concludes that since the specification does not reference

[1] (At least two Office Actions have issued since the filing of the Declaration and yet the argument now relied upon by the Examiner is *first* presented in the Final Rejection.)

what standard is being used in such tests that the claimed terminology must be indefinite. However, it is irrelevant as to what standard is being used to establish the fire rating of the barrier. The claim recites "at least partially reestablishing a fire rating of the barrier." Obviously, whatever standard was used to define the fire rating of the barrier would be the same standard used to reestablish the fire rating. It is illogical to conclude that one standard would be used to define the fire rating and a different standard used to reestablish the fire rating.

The proper inquiry as to whether a claim is definite under the second paragraph of 35 U.S.C. § 112 is whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Appellants have submitted evidence which establishes what is known to those of skill in the art as to how a fire rating is established for a barrier and exemplary protocols for measuring such ratings. That the terminology of "at least partially reestablishing a fire rating of the barrier" would mean bringing the rating back at least partially to its established rating would be clear to those of skill in the art. The Examiner has provided no evidence or logical reasoning to refute the position of Appellants.

Further, the claims clearly set forth the area over which Appellants have defined their invention. As set forth by the Court in *In re Borkowaski*, 164 USPQ 642, 645-646 (CCPA 1970):

> The first sentence of the second paragraph of § 112 is essentially a requirement for precision and definiteness of claim language. If the scope of subject matter embraced by a claim is clear, and if the applicant has not otherwise indicated that he intends the claim to be of a different scope, then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

Appellants have succinctly claimed the metes and bounds of their invention and thus the rejection should be reversed. *In re Moore*, 439 F.2d 1232, 1253, 169 USPQ 236, 238 (CCPA

1971) ("[T]he definiteness of the language employed must be analyzed – not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.") and *In re Mercier*, 185 USPQ 774, 780 (CCPA 1975) ("The purpose of the second paragraph is to ensure that those skilled in the art can determine with precision the metes and bounds of the claims").

2. **Rejection of Claims 23-27, 37-38 and 40 Over *Dykhoff.***

On March 30, 2004, Appellants submitted Declaration of Randy Clark (Exhibit 1 of Appendix 1) to establish completion of Appellants' invention prior to August 25, 2000, the effective filing date of *Dykhoff.*

In the Final Rejection, the Examiner concludes that "Exhibits A through E failed to provide the claimed subject matter" and that the rejection is therefore "proper and just". During the protracted prosecution of this application, the Examiner has never provided any guidance to Appellants as to the alleged insufficiency of the showings submitted by Appellants but has consistently made the conclusory statements that the Exhibits are "insufficient". (At one juncture, the Examiner premised his position on an improper reading of 37 CFR § 1.131 to require a single Exhibit to contain all elements of a claim.)

Since the "same patentable invention" is not being claimed by Appellants and *Dykhoff* (wherein the claimed invention is directed to the use of "infrared blocking materials"), the submission of a Rule 131 Declaration is a proper submission by Appellants.

The Declaration clearly establishes reestablishment of a fire rating of a compromised barrier by use of an intumescent gasket. Exhibit A references "a gasket" behind a cover plate of an outlet box. Page 2 of Exhibit A references the gasket as being composed of an intumescent material and Exhibit B discloses the intumescent material as being "hydrated aluminum silicate

acid treated flake graphite." This graphite is described in the specification as the "base intumescent sheet." Exhibits D and E establish the completion of the invention relating to the reestablishment of the fire rating of the barrier using the intumescent material.

37 CFR § 1.131 only requires the Declaration to "establish invention of the subject matter of the rejected claim prior to the effective date of the reference. . . . " Appellants have provided supporting documentation which establishes the date of invention prior to August 25, 2000. In light of the previously submitted Declaration, the rejection of the claims over *Dykhoff* should not be maintained.

3. **Rejection of the Claims over *Close* in view of *Landin*.**

Close discloses use of a "spongy, compressible, sealing gasket" of air-impervious material which is compressed between the wall panel and the cover of an electrical box in order to prevent air infiltration. As such, the gasket of *Close* prevents cool air from flowing into the room (col. 3, ll. 55-59). While col. 5, ll. 41-45 states that the gasket may exhibit fire retardant properties, the gasket of *Close* does not exhibit the claimed fire resistant insulative properties. The gasket of *Close* is plastic! Plastics are not fire resistant insulative materials.

The Examiner relies upon *Landin* to cure the deficiencies of *Close*. *Landin* merely discloses intumescent materials such as graphite. There is no reason to substitute the intumescent material of *Landin* for the "spongy, compressible, sealing gaskets or thin non-compressible but flexible gasket" (col. 1, ll. 65-68) of *Close* This is especially true since the plastic gaskets of *Close* are used to prevent air infiltration and thus cool air into the room.

In any event, *Close* fails to disclose the methodology that is the crux of Appellants' invention. The compromised barrier of Appellants' claims has a defined fire rating. The claims of Appellants are directed to a method of reestablishing the (loss in) fire rating, when

compromised by, for example, an electrical box. The Examiner argues that "the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." (P. 18, ¶ E.) The "suggestion" of combining the references must be evident from the references themselves. There is no suggestion in the references that they be combined. No motivation exists as to why one would have combined the references especially since *Close* does not disclose the use of such thermal insulating materials to assist compromised barriers such as in the reestablishment of fire ratings.

VIII. CONCLUSION

The rejections of:

1. Claims 23-27 are indefinite under 35 U.S.C. § 112, ¶ 2;

2. Claims 23-27, 37-38 and 40 under 35 U.S.C. § 103(e) over *Dykhoff* .and

3. Claims 23-26, 37-38 and 40 under 35 U.S.C. § 103(a) over *Close* in view of *Landin*

are improper for the reasons discussed herein.

Reversal of the rejections made by the Examiner is earnestly requested.

Respectfully submitted,

Date: March 27, 2006

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited by First-Class Mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this the 27th day of March, 2006.

Beth A. Sanders

APPENDIX 1

CLAIMS ON APPEAL

23. A method of assisting a compromised barrier, comprising:

a) providing a gasket comprising fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite;

b) placing the fire retardant gasket between a faceplate and an electrical box adapted to be introduced into the barrier;

c) coupling the faceplate to the box; and

d) at least partially reestablishing a fire rating of the barrier.

24. The method of claim 23, further comprising coupling the gasket in situ between the faceplate and the box.

25. The method of claim 23, wherein providing the gasket comprises forming the gasket as a separate element prior to placing the gasket between the faceplate and the box.

26. The method of claim 23, further comprising forming the gasket on one or more surfaces of the faceplate prior to coupling the faceplate to the box.

27. The method of claim 26, wherein the gasket is formed by establishing a coating of the fire retardant material onto the faceplate.

37. A method of assisting a compromised barrier, comprising:

a) installing into a fire-rated barrier an electrical box, the electrical box compromising the fire resistance of the fire-rated barrier;

b) introducing into the electrical box a fire retardant gasket of a fire resistant insulative material containing mineral wool or intumescent graphite; and

c) covering the electrical box with a faceplate.

38. The method of Claim 37, wherein the fire retardant gasket is adhered to the faceplate prior to covering the electrical box with the faceplate.

40. The method of Claim 37, wherein the fire retardant gasket is introduced to the electrical box without removing the electrical box from the fire resistant barrier.

APPENDIX 2

EVIDENCE

1. Declaration Under 37 C.F.R. § 1.131 of Randy Clark

   Submitted March 30, 2004; entered into the record on May 6, 2004

2. ASTM E 814-88

   Submitted March 30, 2004, entered into the record on May 6, 2004

3. ASTM E 119

   Submitted March 30, 2004, entered into the record on May 6, 2004